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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Woodcock Washburn Kurtz
Mackiewicz & Norris LLP
One Liberty Place - 46th Floor
Philadelphia, PA 19103

EXAMINER

PHAM, HUNG Q

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/879,382

Applicant(s)

STOLOFF ET AL.

Examiner

HUNG Q. PHAM

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 11-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 15-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

- Claim 5 has been amended. The objection of claim 5 has been withdrawn.

- Regarding the rejection under 35 U.S.C. § 101, claim 18 has been amended to conform to 35 U.S.C. § 101. The rejection of claim 18 under 35 U.S.C. § 101 has been withdrawn.

- Regarding the rejection under 35 U.S.C. § 112, second paragraph
 - (1) Claim 1 has been amended, however, the clause *where a predetermined number of unmet need submissions have the same primary topic* still makes claim 1 indefinite because the clause is disconnected from whatever is being referenced by this clause.

 - (2) Claim 3 has been amended, however, the clause *the unmet needs having a predetermined number of unmet need submissions* still makes claim 3 indefinite because no *unmet needs having a predetermined number of unmet need submissions* has been recited in the step selecting of claim 1.

 - (3) Claim 15 has been amended, however, the clause *where a predetermined number of unmet need submissions have the same primary topic* still makes

claim 15 indefinite because the clause is disconnected from whatever is being referenced by this clause.

(4) Claim 17 has been amended, however, the clause *the selecting of unmet needs having a predetermined number of unmet need submissions* still makes claim 17 indefinite because no *selecting of unmet needs having a predetermined number of unmet need submissions* has been recited in claim 15.

- Applicant's arguments with respect to the rejection under 35 U.S.C. § 102 have been fully considered but they are not persuasive.

As argued by applicants

(1) at page 8:

Applicants submit that drugstore.com has no teaching of "selecting an unmet need for development" as claimed by Applicants. Claims 1 and 15 recite the selecting of an unmet need relating to medical products for development. In this way, for example, when the number of submissions for an unmet need, e.g., gynecology, has exceeded a predetermined number, that unmet need may be selected for the development of related medical products.

...

Drugstore.com does not teach "selecting an unmet need for development" as claimed by Applicants. In short, there is no teaching or suggestion in page 4 of the drugstore.com web site of "selecting an unmet need for development where a predetermined number of unmet need submissions have the same primary topics" in the manner recited by claims 1 and 15. Therefore, at least for the aforementioned reasons, all of the limitations of claims 1 and 15 are not taught or suggested by drugstore.com.

(2) at page 8:

Applicants submit that, while drugstore.com suggests processing user submitted questions to make available answers to the user, it is not the same as the claimed selecting an unmet need for development of related medical products.

(3) at page 8:

Claims 2, 4, and 7-8 depend from claim 1, and are believed allowable for at least the same reasons as described above with respect to claim 1. Similarly, claims 16, 18, and 21 depend from claim 15, and are believed allowable for at least the same reasons as described above with respect to claim 15.

(4) at page 8:

Regarding the rejection of independent claim 9, the Examiner indicated that drugstore.com teaches the claimed "network accepting an electronic submission indicative of an unmet need for the medical products whereby unmet needs related to the medical products may be determined." Office action, pp. 8-9. Applicants respectfully disagree and submit that drugstore.com does not teach the claimed "accepting an electronic submission indicative of an unmet need for the medical products whereby unmet needs related to the medical products may be determined."

...

Furthermore, although the Examiner indicated drugstore.com discloses that submitted questions with the same primary topic "will be selected for processing to make available answer to the user" (Office action, p. 9), it is not the same as determining unmet needs related to the medical products. Drugstore.com does not teach accepting submissions of an unmet need whereby "unmet needs related to the medical products may be determined" as claimed by Applicants.

(5) at page 9:

However, while drugstore.com teaches accepting submissions of a question related to the user's health or medications, it is not the same as accepting a submission indicative of an unmet need for the medical products, as claimed by Applicants.

Examiner respectfully disagrees.

(1) In response to applicants' argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *when the number of submissions for an unmet need, e.g., gynecology, has exceeded a predetermined number, that unmet need may be selected for the development of related medical products*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As indicated at page 4, a submitted question, e.g., *How can I get relief from my osteoarthritis, as an unmet need* is selected for processing, or *development*, by putting the question into Q&As under a primary topic, e.g., OSTEOARTHRITIS. 1 is *the predetermined number* in order to have an available answer. Otherwise, ASK YOUR PHARMACIST is used to have an email response.

(2) In response to applicants' argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *selecting an unmet need for development of related medical products*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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(3) Claims 2, 4, 7, 8, 16, 18 and 21 depend directly or indirectly to claims 1 and 15. Therefore, these claims are unpatentable for at least the same reasons as discussed above.

(4) In response to applicants' argument with respect to claim 9, examiner respectfully refers applicants to page 4, wherein a plurality of users can input a medical request that are not currently addressed by available medical products in the question form, e.g., *Does fish oil help lower cholesterol?* into SEARCH OUR Q&As box of page 4, or ASK YOUR PHARMACIST at page 3. The question as unmet need is accepted by the website via a SUBMIT QUESTION button. As seen, *Does fish oil help lower cholesterol? is an unmet need for the medical products whereby unmet needs related to the medical products may be determined* by the system to return an answer to the user, and by using SUBMIT QUESTION button, the question is *an electronic submission is accepted by the network*.

(5) A medical request that are not currently addressed by available medical products in the question form, e.g., *Does fish oil help lower cholesterol?*, is an unmet need for the medical products, as claimed by Applicants.

For the above reasons, Examiner believed that rejection of the last Office action was proper.

Election/Restrictions

This application contains claims 11-14 drawn to an invention nonelected without traverse in the Office Action 03/24/2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 15 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As in claim 1,

the clause *where a predetermined number of unmet need submissions have the same primary topic* is indefinite because the clause is disconnected from whatever is being referenced by this clause;

As in claims 3,

the clause *the unmet needs having a predetermined number of unmet need submissions* is indefinite because no *unmet needs having a predetermined number of unmet need submissions* has been recited in the step selecting of claim 1

As in claim 15, the clause *where a predetermined umber of unmet need submissions have the same primary topic* is indefinite because the clause is disconnected from whatever is being referenced by this clause.

As in claim 17, the clause *the selecting of unmet needs having a predetermined number of unmet need submissions* is indefinite because no *selecting of unmet needs having a predetermined number of unmet need submissions* was recited in claim 15.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 2, 4, 7-10, 15, 16, 18 and 21 are rejected under 35 U.S.C. 102(a) as being anticipated by drugstore.com [drugstore.com – online pharmacy & drugstore, prescriptions filled].

Regarding claims 1 and 15, drugstore.com is a computer system implements a method for collecting medical product information, comprising:

providing a web site having information about medical products (drugstore.com, pages 1-2);

accepting on said web site input indicative of an unmet need relating to the medical products from a plurality of users (a plurality of users can input a medical request that are not currently addressed by available medical products in the question form, e.g., *Does fish oil help lower cholesterol?* as indicated at page 4 into SEARCH OUR Q&As box of page 4, or ASK YOUR PHARMACIST at page 3. The question as unmet need is accepted by the website via a SUBMIT QUESTION button);

categorizing the unmet need according to a primary topic (the question or unmet need could be categorized into particular topic, e.g., ARTHRITIS, OSTEOARTHRITIS... as illustrated at page 4);

selecting an unmet need for development where a predetermined number of unmet need submissions have the same primary topic (only those submitted questions with the same primary topic, e.g., OSTEOARTHRITIS in *How can I get relief from my osteoarthritis* of page 4, which have already been answered at least once by pharmacists, will be selected for processing to make available answer to the user. One is the predetermined number in order to have an available answer. Otherwise, ASK YOUR PHARMACIST is used to have an email response).

Regarding claims 2 and 16, drugstore.com teaches all of the claimed subject matter as discussed above with respect to claims 1 and 15, drugstore.com further discloses *the categorization is done performed by each said plurality of users electronically selecting a category* (page 4).

Regarding claim 4, drugstore.com teaches all of the claimed subject matter as discussed above with respect to claim 1, drugstore.com further discloses the step of *providing a gatekeeper such that the gatekeeper filters out input that relates to product complaints* (page 9).

Regarding claims 7 and 21, drugstore.com teaches all of the claimed subject matter as discussed above with respect to claims 1 and 15, drugstore.com further discloses the step of *providing a computer implemented medical products information web site in conjunction with the unmet needs input such that users can input unmet needs while obtaining medical products information* (page 4).

Regarding claim 8, pages 1-10 are created by a computer process, and these imply *a computer-readable medium bearing computer readable instructions for carrying out the steps recited in claim 1.*

Regarding claim 9, drugstore.com is a web site for collecting medical product information, comprising:

a web site wherein the web site stores information about medical products, information about the medical products being electronically searchable and browseable (pages 1 and 2), and a computer that hosts the web site is an inherent feature of pages 1 and 2;

a network connection (WWW) whereby web pages are delivered to a remote computer and input is accepted from the remote computer (any computer that has access to the WWW can retrieve an exist web page by inputting an URL), the network accepting an electronic submission indicative of an unmet need for the medical products (a plurality of users can input a medical request that are not currently addressed by available medical products in the question form, e.g., Does fish oil help lower cholesterol? as indicated at page 4 into SEARCH OUR Q&As box of pate 4, or ASK YOUR PHARMACIST at page 3. The question as unmet need is accepted by the website via a SUBMIT QUESTION button) whereby unmet needs related to the medical products may be determined (those submitted questions with the same primary topic, e.g., OSTEOARTHRITIS in How can I get relief from my osteoarthritis of page 4, which have already been answered at least once by pharmacists, will be selected for processing to make available answer to the user).

Regarding claim 10, drugstore.com further comprising *a medical products purchasing database whereby a user can purchase medical products in conjunction with the submission of an unmet need submission (page 2).*

Regarding claim 18, drugstore.com further comprising the step of *providing a gatekeeper such that the gatekeeper filters out input that relates to product complaints* (page 9).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3, 5, 6, 17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over drugstore.com [drugstore.com – online pharmacy & drugstore, prescriptions filled] in view of Wang et al. [USP 6,766,320 B1].

Regarding claims 3 and 17, drugstore.com teaches all of the claimed subject matter as discussed above with respect to claims 1 and 15, drugstore.com further discloses the step of *selecting of the unmet need having a predetermined number of unmet need submissions* (only those submitted questions with the same primary topic, e.g., OSTEOARTHRITIS in *How can I get relief from my osteoarthritis* of page 4, which have already been answered at least once by pharmacists, will be selected for processing to make available answer to the user). But does not explicitly teach the step of *filtering the unmet needs submissions*. Wang teaches a search engine to match a question to a set of frequently asked questions stored in a database (Wang, Abstract). Wang further discloses the step of filtering the question (Wang, Col. 8, Lines 40-64). It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the drugstore.com technique by including the step of filtering noisy words from an unmet need, e.g., *How can I get relief from my osteoarthritis* of page 4, in order to produce keywords for searching.

Regarding claims 5 and 19, drugstore.com teaches all of the claimed subject matter as discussed above with respect to claims 1 and 15, but does not explicitly teach the step of *providing a gatekeeper such that the gatekeeper filters out input that describes a unmet need and a solution to the unmet need*. Wang teaches a search engine to match a question to a set of frequently asked questions stored in a database (Wang, Abstract). Wang further discloses the step of providing a gatekeeper such that the gatekeeper filters out input that describes a unmet need (Wang, Col. 8, Lines 40-64), and a

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solution to the unmet need (Wang, Col. 11, Line 10-Col. 12, Line 11). It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the drugstore.com technique by including the technique of filtering out unmet need and solution as taught by Wang in order to produce key words for searching and matching with the best answer.

Regarding claims 6 and 20, drugstore.com and Wang, in combination, teach all of the claimed subject matter as discussed above with respect to claims 5 and 19, drugstore.com further discloses *an invention submission disclosure form is transmitted to the user that submitted the unmet need (page 4) and the solution to the unmet need (page 6).*

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q. PHAM whose telephone number is 571-272-4040. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E. BREENE can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HUNG Q PHAM
Examiner
Art Unit 2162

July 21, 2005



SHAHID ALAM
PRIMARY EXAMINER